

Office Action Summary

Application No.

09/810,650

Applicant(s)

URANO ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 7-10 are pending in the application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on July 29, 2003 has been entered.

Rejections made in the previous Office Action which do not appear below have been overcome by Applicants' amendment to the claim. Therefore, arguments pertaining to these rejections will not be addressed.

Claim Objections

Claim 10 is objected to for being substantial duplicate of claim 8.

When two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. M.P.E.P. 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, the description requirements therein.

The introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written disclosure requirement of 35 U.S.C. 112, first paragraph. M.P.E.P. 2163.04 and 2163.05. As stated in *Fujikawa v. Wattansasin*, 93 F.3d 1559, 39 USPQ2D 1985 (Fed. Cir. 1996), “a laundry list disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not reasonably lead those skilled in the art to any particular species.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, the description therein, for reasons essentially given in the last Office Action, pages 2 and 3. More specifically, in claim 8, the expression “wherein R¹ is a cyclic alkyl group in which the alkyl group is hexyl; and R² is a cyclic alkyl group in which the alkyl group is hexyl” lacks description in the original specification and the original claims. However, there is description in the instant specification of U.S. Pat. 5,216,135 (column 2, line 52) for bis(cyclohexylsulfonyl)diazomethane.

Specifically, in claim 9, the expression “ where R¹ is a branched alkyl group in which the alkyl group is butyl; and R² is a branched alkyl group in which the alkyl group is butyl” lacks description in the original specification and the original claims. However, there is description in the instant specification of U.S. Pat. 5,216,135 (column 2, lines 55 and 56) for bis(*tert*-butylsulfonyl)diazomethane and bis(*sec*-butylsulfonyl)-diazomethane.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 of this title before the invention thereof by the applicant for patent.

Claims 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Pawlowski et al. {U.S. Pat. 5,338,641}.

Pawlowski et al. disclose compounds which are embraced by the instant claimed invention and therefore, anticipate the instant claimed invention. See the following table.

Applicants' Compounds	Pawlowski et al.'s Compounds	Claims Anticipated
R ¹ and R ² are each cyclohexyl	Bis(cyclohexylsulfonyl)diazomethane (column 4, line 46)	Claims 8 and 10
R ¹ and R ² are each <i>iso</i> -butyl	Bis (2-methylpropylsulfonyl)diazomethane (column 4, line 33)	Claim 9
R ¹ and R ² are each <i>sec</i> -butyl	Bis(1-methylpropylsulfonyl)diazomethane (column 4, line 32)	Claim 9

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlowski et al. {U.S. Pat. 5,338,641}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim diazodisulfones. Pawlowski et al. teach diazodisulfones {e.g., α,α -bis(sulfonyl)diazomethanes} which are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed compounds. See in the reference, for example, wherein R represents butyl (including positional isomers – e.g., *tert*-butyl) or cyclohexyl {column 3, lines 8-15, 40-49, 66-68; column 4, lines 1-2; and especially the compounds in column 4, lines 32-34}.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in Pawlowski et al.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of “some” among “many” is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., forms a strong acid on exposure to actinic radiation).

One skilled in the art would thus be motivated to prepare compounds embraced by the reference genus to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in forming a strong acid on exposure to actinic radiation. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Allowable Subject Matter

Claim 7 is free of the art of record for reasons already of record in Paper No. 39, pages 4-5. Therefore, claim 7 is allowed.

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents **must** be submitted in response to this Office action.

Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, which will be strictly enforced.

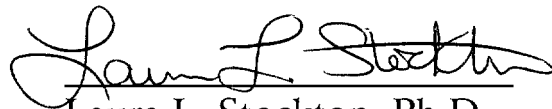
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

December 3, 2003